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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,805	11/18/2003	Timothy R. Piwonka-Corle	TNCR.059US6	8189
36257	7590	06/07/2004	EXAMINER	
PARSONS HSUE & DE RUNTZ LLP 655 MONTGOMERY STREET SUITE 1800 SAN FRANCISCO, CA 94111			ROSENBERGER, RICHARD A	
			ART UNIT	PAPER NUMBER
			2877	

DATE MAILED: 06/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/716,805

Applicant(s)

PIWONKA-CORLE ET AL.

Examiner

Richard A Rosenberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

1. Claims 1-52 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over what is claimed is U.S. Patent Nos. 5,608,526. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are directed to the same invention, although with differing scopes.

Instant independent claim 1 is similar to but broader than independent claim 1 of US 5,608,526. Instant independent claim 28 is similar to but broader than claim 25 of US 5,608,526. Independent claims 43 and 48 are similar to but broader than 39 and 44 of the patent. The various instant dependent claims all appear to be substantially similar to the various dependent claims of the patent.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 43-46 and 48-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art discussed in the specification in view of Kuriyama et al (US 4,865,445) and Jann et al (US 5,189,481).

It is known to make both ellipsometric and spectrophotometric measurements on a sample; see the discussion of prior art in the instant specification. It is in general known that two different tests can be performed by a single instrument comprising the two instruments for the two tests and containing a single light source for both, either making the two measurements simultaneously using a beam splitter to obtain two light beams from the light source or by selectively switching the light from the light source to one of the other of the two instruments. The general combination of two measuring instruments is shown by Kuriyama et al and by Jann et al, which two references also show both arrangements for supplying light to the two instruments. The use in such a combination instrument of any known arrangements, including a known ellipsometer and known spectrophotometer, would have been obvious.

5. Batten (US 4,210,401) shows a polarization system using reflective optics to focus the beams in the instrument. The art does not show having the reflective

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optics after the polarizer, and does not show the step of reflectively focusing the sample beam after the step of polarizing the beam; rather the Batten reference shows placing the polarizer after the reflective focusing element. This claims placement of the polarizer relative to the reflective optics and sample is not obvious as those in the art would have expected the reflection of the polarized light by the reflective element to cause unwanted changed in the polarization state of the polarized beam which would degrade the measurement. Thus claims 1-42 would be allowable were a terminal disclaimer filed to overcome the obviousness-type double patenting rejection above, and claims 47 and 52 would be allowable were the terminal disclaimer filed and the claims rewritten in independent form including all of the limitations of their respective parent claims.

6. Papers related to this application may be submitted to Group 2800 by facsimile transmission. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (15 November 1989). The fax number is (703) 872-9306

Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. A. Rosenberger whose telephone number is (571) 272-2428.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.

R. A. Rosenberger
26 May 2004



Richard A. Rosenberger
Primary Examiner